

REMARKS/ARGUMENTS

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action. In the outstanding Official Action, claims 1-12 and 14-25 (claim 13 having been previously canceled) were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-12, 14-17, 19, 21, and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over RICHMAN (U.S. Patent No. 6,754,874 B1) in view of WHITACRE et al. (U.S. Patent Application Publication No. 2004/0138944 A1). Claims 18, 20, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over RICHMAN in view of WHITACRE and NANOS et al. (U.S. Patent No. 6,381,744 B2).

Upon entry of the amendment, claims 1, 9, 12, and 24-25 have been amended. Claim 13 was previously canceled. Thus, claims 1-12 and 14-25 are currently pending for consideration by the Examiner.

The 35 U.S.C. § 101 Rejection

Claims 1-12 and 14-25 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter, citing the U.S. Supreme Court cases *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); and *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). In particular, the Official Action asserted that method claims 1- 24 were non-statutory since independent method claims 1 and 24 were not tied to an apparatus, did not transform the underlying subject matter to a different state or thing, and were capable of being carried out by the human mind.

Amended independent claims 1 and 24 now claim automated processes that are closely tied to a computer that is configured as having a scorecard engine and a plurality of databases,

including a coaching comment database. From reviewing the individual process elements, it is evident that the specifically configured computer imposes meaningful limits on the claim scope since many of the process elements are automatically performed by the computer. Thus, method claims 1 and 24 represent statutory subject matter since they are now tied to a particular apparatus.

Amended independent method claims 1 and 24 also transform survey responses into a performance survey subject scorecard representing the actual survey subject's physical performance during a limited time period. This transformation of the survey subject scorecard into a different state or thing is central to the overall purpose of the processes. Since the claimed processes are restricted to the practical application of the principle to transform specific survey responses into a performance subject scorecard that represents the survey subject's physical performance during a limited period of time, claims 1 and 24 also represent statutory subject matter based upon this transformation.

Amended independent method claims 1 and 24 also explicitly recite the automatic implementation of various significant features using a computer, a scorecard engine, and a plurality of databases that distinguish over a process that is carried out by a human mind. Thus, amended method claims 1-24 recite statutory subject matter.

With regard to independent system claim 25, the Official Action asserted that the system did not recite any physical structure such as computer hardware, and thus did not fall into one of the statutory classes of patentable subject matter. Amended independent system claim 25 is directed an overall system for creating a customer feedback performance scorecard. In addition to a customer service research center, the overall system explicitly recites a computer system that has a plurality of databases, and a customer feedback performance scorecard engine that interacts

with the databases. Thus, amended independent system claim 25 falls into the machine category of patent-eligible subject matter under 35 U.S.C. § 101. In view of the above discussion, pending claims 1-12 and 14-25 are directed at statutory subject matter, and Applicants respectfully request that the rejection of claims 1-12 and 14-25 under 35 U.S.C. § 101 be withdrawn.

The 35 U.S.C. § 103(a) Rejection

Claims 1-12, 14-17, 19, 21, and 23-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over RICHMAN in view of WHITACRE. With regard to independent method claim 1, the Official Action asserts that RICHMAN discloses all of the method elements, except for the determination of a performance trend and the determining of a coaching comment based on various data including the performance trend data. However, the Official Action asserts that WHITACRE teaches the determination and use of performance trends, and concludes that the combination of RICHMAN and WHITACRE render claim 1 obvious.

Contrary to the Official Action's assertions, while the combination of RICHMAN and WHITACRE may be superficially similar to the method recited in claim 1, there is a fundamental difference between the combination of RICHMAN and WHITACRE and claim 1 that patentably distinguishes claim 1 over the applied references. Applicants' claim 1 is directed to an automated method for aggregating and reporting customer feedback information using a computer that includes scorecard engine and a storage device that stores a plurality of databases. Upon conducting and collecting survey responses, which may be performed in one or more of various ways, the development and preparation of the performance survey subject scorecard is performed automatically by the computer's scorecard engine interacting with a plurality of

databases, without the need for human participation. Thus, the performance scorecard is prepared much more timely and consistently than is done under the traditional method of performance scorecard preparation.

In contrast, RICHMAN discloses a traditional performance scorecard preparation method that is merely aided by a computer system, not automatically performed by a computer system interacting with various databases. A flowchart of RICHMAN's performance scorecard process is illustrated in RICHMAN's Figure 3 and shows that the scorecard preparation process is mostly a manual process that uses a computer for convenience. For instance, claim 1 recites that performance scores are determined automatically by the scorecard engine. In contrast, RICHMAN's Figure 3 discloses in flowchart block 330 that the feedback provider endorses and submits the scorecard. In column 9, lines 10-15, RICHMAN states that the feedback provider manually enters performance rating information for each competency area and enters free form text feedback in the comment field.

Claim 1 also recites that the feedback analysis information is automatically assembled by the scorecard engine. In addition to the manual entry of performance rating information discussed above, RICHMAN also discloses in Figure 3 that a second level reviewer similar enters manual performance rating information (flowchart block 340), that the feedback provider manually enters comments again (flowchart block 350), and that a project evaluation meeting is held between the feedback receiver and the feedback provider (flowchart block 355). Further, RICHMAN discloses in column 10, lines 24-36, that the prepared scorecard serves as an agenda for the meeting, and is afterwards manually edited based upon the meeting.

Claim 1 also recites that the scorecard engine automatically queries a coaching comment database using the feedback analysis information associated with the survey subject and the

performance category in order to obtain a relevant coaching comment from a plurality of predefined coaching comments. As discussed above, RICHMAN discloses in Figure 3 and the corresponding discussion in the specification that the feedback provider's comments are manually prepared and entered. RICHMAN fails to disclose a coaching comment database that stores predefined coaching comments and that are automatically selected based upon a survey subject's feedback analysis information and performance category.

The above discussion recites examples of how RICHMAN discloses a traditional performance scorecard preparation method that is merely aided by a computer system, and not automatically performed by the computer system interacting with a plurality of databases as recited in claim 1. Further, the deficiencies of RICHMAN are not remedied by WHITACRE. Similar to RICHMAN's method, WHITACRE resorts to a team leader using a supervision/management computer (52) to manually enter data to update an agent's performance on a scorecard (54), as evidenced by WHITACRE's paragraph [0039].

The rejection of claim 1 concludes with the Official Action taking Official Notice that it was well-known in the art at the time of the invention was made to use databases to make recommendations or suggestions based on input. A review of M.P.E.P. Section 2144.03 indicates that Official Notice without documentary evidence is permissible only in some circumstances where the asserted common knowledge is capable of instant and unquestionable demonstration as being well-known. Additionally, this M.P.E.P. section specifically states that when Applicants point out why the noticed facts are not common knowledge, then the Examiner must provide documentary evidence in the next Official Action if the rejection is to be maintained. See also 37 C.F.R. § 1.104(d)(2).

In this case, the need for appropriate documentary evidence is exceptionally important since the Official Notice is related to a key aspect of Applicants' claims, including the fact that Applicants are not claiming the generic querying of a database, but instead are claiming a specific manner of querying a coaching comment database integrated into an automated method for preparing a performance survey subject scorecard, for which no specific documentary evidence has been provided. Further, this specific manner of automatically querying a coaching comment database is not common knowledge, as evidenced by the fact that neither of the applied references disclose, teach, or suggest this feature. Thus, Applicants respectfully believe that Official Notice is not appropriate in this specific instance.

For at least the reasons stated above, claim 1 would not have been obvious to one of ordinary skill in the art at the time of the invention in view of RICHMAN and WHITACRE. Claims 2-12 and 14-23, which depend either directly or indirectly from independent claim 1, are also believed to be patentable for at least the reasons discussed above with regard to independent claim 1, and further for the additional features recited therein.

The Official Action states that since independent claims 24 and 25 are substantially similar to claim 1, that they are rejected under a similar rationale. Thus, claims 24 and 25 are also believed to be patentable for reasons similar to those stated above with regard to claim 1. Accordingly, Applicants respectfully request that the rejection of independent claim 1-12 and 14-25 be withdrawn, and an indication of allowance of claim 1-12 and 14-25 be provided in the next Official communication.

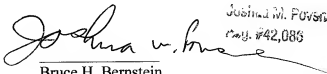
Applicants note that the amendment is being made to advance prosecution of the application to allowance, and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further,

no acquiescence as to the propriety of the Examiner's rejections is made by the present amendment. All other amendments to the claims that have been made in this amendment should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,

Patrick Stamm et al.


Bruce H. Bernstein
Reg. No. 29027

Justin M. Fover
Reg. #42,083

January 19, 2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191